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| 10/532,562 | 04/25/2005 | Nobutaka Fukagawa | 033231-006 | 4281 |
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| EXAMINER | | | | |
| WOLLSCHLAGER, JEFFREY MICHAEL | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1791 | | | | |
| NOTIFICATION DATE | | DELIVERY MODE | | |
| 03/17/2008 | | ELECTRONIC | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

Office Action Summary

Application No.

10/532,562

Applicant(s)

FUKAGAWA ET AL.

Examiner

Jeff Wollschlaeger

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 12 is/are pending in the application.
- 4a) Of the above claim(s) 5-11 and 13-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB08)
- Paper No(s)/Mail Date 4/25/06
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election of Group I, claims 1-4 and 12, in the reply filed on December 28, 2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 5-11 and 13-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 2, 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori et al. (WO 00/65384) in view of JP 11-058425. *Note: citations to Mori et al. are provided from the US equivalent document US 7,166,339.*

Regarding claim 1, Mori et al. teach a method of producing a cellulose acetate film (the examiner notes that cellulose acetate is a species of the genus cellulose acylate and further notes that this is acknowledged in the instant disclosure US 2006/0051526, paragraphs [0116 and 0142]) wherein a solution of cellulose acetate containing a retardation increasing compound comprising an aromatic compound having at least two aromatic rings within the claimed weight ranges (col. 3, lines 35-65) is formed (col. 45, lines 2-26; Example 1). The solution is cast onto a drum or band (col. 46, lines 63-65; col. 47, lines 1-9). After casting, the solution is dried with "flowing air" and is peeled off the drum or band and can then be further dried (col. 47, lines 9-15). Mori et al. do not disclose that the velocity/wind speed of the "flowing air" is at least 10 m/min during a first half of drying prior to peel-off.

However, JP 11-058425 teaches an analogous method of forming a film on a drum/belt wherein the film is dried by passing air at a speed of 0.1-2 m/sec (6 -120 m/min) during a first stage of drying followed by an even more rapid drying of the film in a second stage (Abstract).

Therefore it would have been *prima facie* obvious to one having ordinary skill in the art at the time of the claimed invention to have modified the method of Mori et al. and to have employed the drying method of JP 11-058425, for the purpose, as suggested by JP 11-058425, of rapidly drying the film

As to claim 2, Mori et al. disclose that the average acetic acid content (i.e. degree of acylation) is preferably in the range of 55.0 to 61.0% (col. 3, lines 43-45) and exemplify a value of 60.9% (col. 46, lines 48-49).

As to claim 4, the combination employs the same claimed materials and performs the same claimed process in the same claimed manner. Accordingly, it follows that the same claimed effects and physical properties (e.g. retardation value R_e) would be achieved by practicing the combined method.

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As to claim 12, Mori et al. teach the cellulose acetate film is cast as a single layer (Example 1; col. 3, lines 28-31). As such, the layer is reasonably understood to be an outermost layer.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mori et al. (WO 00/65384) in view of JP 11-058425, as applied to claims 1, 2, 4 and 12 above, in view of Ito et al. (WO 01/88574). *Note: citations to Ito et al. are provided from the US equivalent document US 7,084,944.*

As to claim 3, the combination teaches the method set forth above. Further, while Mori et al. employ and disclose 1, 3, 5-triazine based aromatic retardation increasing compounds (col. 4, lines 2-16; col. 8 – col. 20), Mori et al. do not teach the 1, 3, 5-triazine based compounds as claimed.

However, Ito et al. teach an analogous method of producing a film wherein an aromatic retardation increasing compound of the required composition is employed (Abstract; col. 62, lines 41-56).

Therefore it would have been *prima facie* obvious to one having ordinary skill in the art at the time of the claimed invention to have modified the method of Mori et al. and to have employed the retardation increasing compound(s) suggested by Ito et al. for the purpose of further improving and achieving the desired retardation of the cast film.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff Wollschlager whose telephone number is (571)272-8937. The examiner can normally be reached on Monday - Thursday 6:45 - 4:15, alternating Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on 571-272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. W./
Examiner, Art Unit 1791

March 19, 2008

/Monica A Huson/
Primary Examiner, Art Unit 1791